

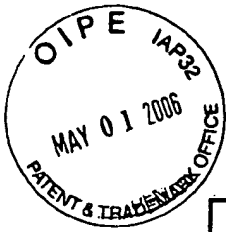
Based on Form PTO-1449 (3/90)				ATTY. DOCKET NO.  <b>830010-2002.3</b>		SERIAL NO.  <b>To Be Assigned</b>		
LIST OF REFERENCES CITED BY APPLICANT (Use several sheets if necessary)				APPLICANT  <b>Pasternak et al.</b>				
				FILING DATE  <b>Herewith</b>		GROUP  <b>To Be Assigned</b>		
U.S. PATENT DOCUMENTS								
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE	
LW	AA	5,866,143	02/02/99	Elkhoury				
	AB	5,654,281	08/05/97	Mayer, et al.				
	AC	5,523,323	06/04/96	Maccacchini				
	AD	5,321,012	06/14/94	Mayer, et al.				
	AE	5,689,489	11/18/97	Shin				
	AF	5,840,731	11/24/98	Mayer, et al.				
	AG	5,869,498	02/09/99	Mayer, et al.				
	AH	5,589,480	12/31/96	Elkhoury, et al.				
	AI	5,834,480	11/10/98	Elkhoury				
	AJ	4,626,539	12/02/86	Aungst, et al.				
LW	AK	5,635,204	06/03/97	Gevirtz, et al.				
FOREIGN PATENT DOCUMENTS								
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
LW	AL	WO 97/10815	03/27/97	WIPO				
	AM	WO 94/14427	07/07/94	WIPO				
	AN	WO 98/31358	07/23/98	WIPO				
	AO	WO 98/14427	04/09/98	WIPO				
LW	AP	WO 98/26770	6/25/98	WIPO				
OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)								
LW	AQ		Adams et al. (1993) J. Pharmacol. Exp. Ther. 266(3): 1261-1267					
	AR		Atanassoff et al (1997) Anesth. Analg. 84: 1340-1343					
	AS		Butterworth and Strichartz (1990) Anesthesiol. 72: 711-734					
	AT		Bliss & Collingridge (1993) Nature 361: 31-39					
	AU		Catterall (1992) Science 242: 50-61					
LW	AV		Catterall and Mackie (1996) Goodman & Gilman's, The pharmacologic basis of therapeutics, Ninth Edition (Hardman et al eds.) McGraw-Hill pp.331-347					
EXAMINER				/Leonard Williams/ (07/24/2006)		DATE CONSIDERED		
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U.S. PATENT DOCUMENTS								
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LW	AW	4,446,140	05/01/84	Nelson				
	AX	5,686,112	11/11/97	Liedtke				
	AY	6,191,126	02/20/01	Garrache				
	AZ	6,383,511	05/07/02	Cassel				
LW	BA	5,948,389	09/07/99	Stein				
	BB							
	BC							
	BD							
	BE							
FOREIGN PATENT DOCUMENTS								
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
LW	BF	WO 00/03716	01/27/00	WIPO				
LW	BG	JP 2000-169378	06/20/00	Japan (Abstract)				
	BH							
	BI							
	BJ							
	BK							
OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)								
LW	BL		Courtney and Strichartz (1987) Handbook of Experimental Pharmacology, vol. 81. (Strichartz ed.) Springer-Verlag pp. 53-94					
	BM		Chen et al (1993) Mol. Pharmacol. 44: 8-12					
	BN		Hanson (1995) Remington: The Science and Practice of Pharmacy, 17 <sup>th</sup> edition, Mack Publishing Company p. 1146-1153					
	BO		Elliot et al. (1994) Pain 56: 69-75					
	BP		He and Lee (1998) J. Pharmacol. Exp. Ther. 285: 1181-1186					
LW	BQ		Horan et al. (1992) Life Sci. 50: 1535-1541					
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	BS						
	BT						
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES      NO
	BU						
	BV						
OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)							
LW	BW	Kolesnikov and Pasternak (1999) J. Pharmacol. Exp. Ther. 290(1): 247-252					
	BX	Kolesnikov et al. (1996) Eur. J. Pharmacol. 310: 141-143					
	BY	Kolesnikov et al. (1996) J. Pharmacol. Exp. Ther. 279(2): 502-506					
	BZ	Kolesnikov et al. (1994) Life Sci. 55: 1393-1398					
	CA	Kolesnikov et al. (1993) Proc. Natl. Acad. Sci. USA 90: 5162-5166					
	CB	Kolesnikov Y.A. et al. "Peripheral blockade of topical morphine tolerance by ketamine" European Journal of Pharmacology, 1999, 374/2					
	CC	Lutz and Pfister (1992) J. Receptor Res. 12: 267-286					
	CD	Olson et al. (1989) Peptides 10: 1253-1280					
	CE	Pasternak (1993) Clin. Neuropharmacol. 16(1): 1-18					
	CF	Portoghese et al. (1992) Eur. J. Pharmacol. 218: 195-196					
	CG	Reisine and Pasternak (1996) Goodman & Gilman's, The pharmacological basis of Therapeutics, Ninth Edition (Hardman et al. Eds.) McGraw-Hill pp. 521-555					
	CH	Rossi et al (1994) Brain Res. 665: 85-93					
	CI	Saito et al. (1998) Anesthesiol. 89: 1455-1463					
	CJ	Saito et al (1998) Anesthesiol 89: 1464-1470					
	CK	Sibinga et al. (1998) Annu. Rev. Immunol. 6: 219-249					
LW	CL	Simon (1991) Medicinal res. Rev. 11: 357-374					
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	CM						
	CN						
	CO						
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES      NO
	CP						
	CQ						
OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)							
LW	CR		Sofuoglu et al. (1991) J. Pharmacol. Ther. 257(2): 676-680				
	CS		Standifer and Pasternak (1997) Cell Signal. 9, (No. 4): 237-248				
	CT		Standifer et al. (1996) Mol. Pharmacol. 50: 293-298				
	CU		Trujillo and Akil (1991) Science 251: 85-86				
	CV		Yasuda et al (1993) Proc. Natl. Acad.Sci. USA 90: 6736-6740				
	CW		Yeung and Rudy (1980) J. Pharmacol. Exp. Ther. 215(3): 633-642				
	CX		Kolesnikov Yuri A et al. "Analgesic synergy between topical lidocaine and topical opioids" Journal of Pharmacology and Experimental Therapeutics, vo. 295, no. 2, November 2000 (2000-11) pages 546-551, XP 001080389				
	CY		Khouri G F et al. "Intraarticular Morphine, Bupivacaine, and Morphine/Bupivacaine for pain control after knee videoarthroscopy" Anesthesiology, American Society of Anesthesiologists, Philadelphia, PA, US, vol. 77, no. 263, 1992, pages 263-266, XP000910063				
	CZ		Kaneko Megumi et al. "Synergistic antinociceptive interaction after epidural coadministration of morphine and lidocaine in rats." Anesthesiology, vol. 80, no. 1, 1994, pages 137-150, XP001080405				
	DA		Saito Yoji et al. "Interaction of intrathecally infused morphine and lidocaine in rats (Part 1)." Anesthesiology (Hagerstown), vol. 89, no. 6, December 1998 (1998-12) pages 1455-1463, XP001080402				
	DB		Atanassoff Peter G et al. "The effect of intradermal administration of lidocaine and morphine on the response to thermal stimulation." Anesthesia & Analgesia, vol. 84, no. 6, 1997, pages 1340-1343, XP001079098				
	DC		Roy et al. " Transdermal Delivery of Narcotic Analgesics: Comparative Metabolism and Permeability of Human Cadaver Skin and Hairless Mouse Skin" Journal of Pharmaceutical Sciences, vol. 83 (12) December 1994, pages 1723-1728.				
	DD		Roy et al. "Transdermal Delivery of Narcotic Analgesics: Comparative Permeabilities of Narcotic Analgesics Through Human Cadaver Skin", Pharmaceutical Research, vol. 6(10) 1989, pages 825-832.				
LW	DE		Picard et al, "Analgesic efficacy of peripheral opioids (all except intra-articular): a qualitative systematic review of randomized controlled trials" Pain , Sept(72(3) 1997, 309-318				
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	DF						
	DG						
	DH						
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES      NO
	DI						
	DJ						
OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)							
LW	DK		Moore et al. "The efficacy of locally applied morphine in post-operative pain after bilateral third molar surgery." Br J Clin Pharmacol 1994 Mar 37(3):227-30				
	DL		Leopold et al. "Percutaneous Penetration of Local Anesthetic Bases: Pharmacodynamic Measurements" The Journal of Investigative Dermatology, vol 113(3), September 1999, pages 304-307				
	DM		Saito et al. "Interaction of Intrathecally Infused Morphine and Lidocaine in Rats (Part I), Anesthesiology, vol. 89, 1988, pages 1455-63				
	DN		Raja et al. "Comparison of postoperative analgesic effects of intraarticular bupivacaine and morphine following arthroscopic knee surgery." Anesthesiology 1992, Dec. 77(6): pages 1143-7.				
	DO		Rosseland et al. "Intra-articular morphine for pain relief after knee arthroscopy" Acta Anaesthesiol Scand 1999 Mar 43(3): 252-7.				
	DP		Fletcher et al. "Additivity of bupivacaine and morphine for peripheral analgesia in rats." Fundam Clin Pharmacol. 2000 July-Aug; 14(4), pages 327-34				
	DQ		Yarussi et al. "Evaluation of peripheral morphine analgesia for lumpectomy and axillary node dissection: a randomized, double-blind, placebo-controlled study." Reg. Anesth Pain Med 1999, Mar-Apr; 24(2), pages 142-145.				
	DR		Rosenstock et al. "Analgesic effect of incisional morphine following inguinal herniotomy under spinal anesthesia" Reg Anesth 1996 Mar-Apr, 21(2), pages 93-98.				
LW	DS		Merriam-Webster's Collegiate Dictionary. 10 <sup>th</sup> ed. (1999), "potentiate" page 912, Merriam-Webster, Incorporated.				
	DT						
	DU						
	DV						
	DW						
	DX						
EXAMINER  <b>/Leonard Williams/ (07/24/2006)</b>				DATE CONSIDERED			
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<b>Substitute for form 1449A/B/PTO</b>  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)				<b>Complete if Known</b>	
				Application Number	10/823,365-Conf. #4859
				Filing Date	April 13, 2004
				First Named Inventor	Gavril W. Pasternak
				Art Unit	1617
				Examiner Name	G. W. Mitchell
Sheet	1	of	1	Attorney Docket Number	62069DIV2(51590)

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>3</sup>
		Country Code <sup>2</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)				

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
LW	CA	Kolesnikov, Yuri A., et al., Analgesic Synergy Between Topical Morphine and Butamben in Mice, Department of Anesthesiology and Laboratory of Molecular Neuropharmacology, Memorial-Sloan Kettering Cancer Center, New York, NY, Anesth Analg 2003;97:1103-7.	

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<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature	/Leonard Williams/ (07/24/2006)	Date Considered	
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : Pasternak et al.  
U.S. Serial No. : To Be Assigned  
Filing Date : Herewith  
For : TOPICAL ANESTHETIC/OPIOID  
FORMULATIONS AND USES THEREOF  
Group Art Unit : To Be Assigned

745 Fifth Avenue  
New York, NY 10151

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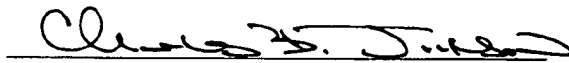
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Date of Deposit: April 13, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Charles B. Jackson

(Typed or printed name of person mailing paper or fee)



(Signature of person mailing paper or fee)

**INFORMATION DISCLOSURE STATEMENT**

Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Examiner's attention is respectfully drawn to the documents listed on the accompanying PTO form 1449. A copy of these documents was previously submitted to or cited by the USPTO in predecessor application Serial No. 09/975,812, filed October 11, 2001. Accordingly, no copy of these documents is submitted herewith.

applications. Applicant submits herewith copies of foreign and non-patents in accordance with 37 CFR 1.98(a)(2).

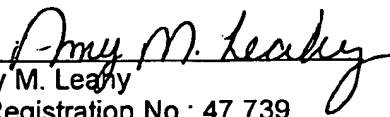
In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR 1.56(a) exists. In accordance with 37 CFR 1.97(h), the filing of this Information Disclosure statement shall not be construed to be an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references.

Please charge our Deposit Account No. 04-1105 in the amount of \$180.00 covering the fee set forth in 37 CFR 1.17(p). The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 62069DIV2(51590). A duplicate copy of this paper is enclosed.

Dated: May 1, 2006

Respectfully submitted,

By   
Amy M. Leamy

Registration No.: 47,739  
EDWARDS ANGELL PALMER & DODGE LLP  
P.O. Box 55874  
Boston, Massachusetts 02205  
(203) 353-6817  
Attorney/Agent For Applicants



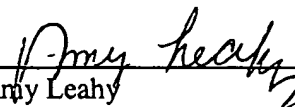
As this Information Disclosure Statement is being filed before the mailing of the first Office Action, it is believed that no fee is required for entry of this paper. However, the Commissioner is hereby authorized to charge any such fee, or credit any overpayment to Deposit Account 50-0320.

The filing of this Information Disclosure Statement is not an admission that the documents identified herein constitute prior art to the present application.

Applicants respectfully request that the Examiner considers and makes of record the documents cited herewith and that a copy of Form PTO-1449 be initialed by the Examiner and returned to the undersigned.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

  
\_\_\_\_\_  
Amy Leahy  
Reg. No. 47,739  
(212) 588-0800

Encs. PTO Form 1449